

**PATENT** 

Attorney Docket No.: GENE1120-1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nolan et al.		)	Group Art Unit: 3762
Applic	eation No.: 09/342,024	)	Examiner: Unassigned  CERTIFICATION UNDER 37 CFR § 1.8
Filed: June 28, 1999		)	I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first
For:	HIGH EFFICIENCY TRANSFECTION BASED ON LOW ELECTRIC FIELD STRENGTH, LONG PULSE LENGTH	) ) )	class mail on this date <b>January 26, 2000</b> , in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231  **Commissioner for Patents of Research Commissioner for Research
		) ) )	(Name of person mailing paper)  Signature

**Box MISSING PARTS** Assistant Commissioner of Patents Washington, D.C. 20231

# PETITION TO ACCEPT FILING OF DECLARATION UNDER 37 C.F.R. § 1.47

Applicant hereby petitions for filing of declaration on behalf of himself and non-signing inventor under 37 C.F.R. § 1.47.

In response to the Notice to File Missing Parts of Application mailed July 27, 1999, and to fulfil the requirements of filing under 37 C.F.R. § 1.53, Applicant submits an executed Declaration for Patent Application signed by Inventor Ed Nolan. A Declaration for Patent
Application signed by Inventor Robin Filshie is not included with the response as Inventor
Filshie can not be found despite diligent effort. A Declaration of Facts fully describing the exact facts that are relied upon to establish that a diligent effort was made is attached hereto.

Gray Cary\GT\6165227.1
104648-990000 Declaration for Patent Application signed by Inventor Ed Nolan. A Declaration for Patent

In re Application of: Nolan et al.

Application No.: 09/342,024

Filed: June 28, 1999

Page 2

PATENT Attorney Docket No.: GENE1120-1

The last known address of the non-signing inventor is the following:

Robin Filshie 406 Rushton Road Toronto, Ontario M6C 2X9 CANADA

The Commissioner is hereby authorized to charge \$130.00 to cover the fee for filing this petition and any associated fees, or credit overpayment to Deposit Account No. <u>07-1895</u>. A copy of the Transmittal Sheet is enclosed.

Respectfully submitted,

Date: 126 00

Lisa A. Haile, Ph.D. Registration No. 38,347

Telephone: (858) 677-1456 Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP 4365 Executive Drive, Suite 1600 San Diego, California 92121-2189



PATENT Attorney Docket No.: GENE1120-1

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:		)	Group Art Unit: 3/62
Nolan et al.		)	
		)	Examiner: Unassigned
Applic	eation No.: 09/342,024	)	
		)	CERTIFICATION UNDER 37 CFR § 1.8
Filed:	June 28, 1999	)	I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first
For:	HIGH EFFICIENCY TRANSFECTION	í	class mail on this date January 26, 2000, in an envelope
	BASED ON LOW ELECTRIC FIELD	Ś	addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231
	STRENGTH, LONG PULSE LENGTH	j	Chrabeth war
		)	(Name of person mailing paper)
		)	ZDiuX
		)	Signature \( \int \)

Box MISSING PARTS Assistant Commissioner of Patents Washington, D.C. 20231

#### **DECLARATION OF FACTS**

#### I. Lisa A. Haile declare that:

- 1. Robin Filshie was employed by BIOCATALYST YORKTON INC., located in Toronto, Ontario. Canada, and is obligated to assign the Invention to GENETRONICS, INC.:
- 2. A letter was sent to Dr. Dietmar Rabussay, Vice President of Research & Development of GENETRONICS, INC., on October 11, 1999 notifying Dr. Rabussay of the requirement that each inventor sign a Declaration for Patent Application (Exhibit A: letter to Dr. Rabussay);
- 3. A Declaration for Patent Application was sent by Federal Express International Priority Letter Service to Inventor Filshie on October 12, 1999 for his execution. (Exhibit B: Federal Express International Waybill);
- 4. The Declaration described in item 3 was returned as undeliverable by Federal Express on October 19, 1999 (Exhibit C: Federal Express Receipt);

In re Application of: Nolan et al.

Application No.: 09/342,024

Filed: June 28, 1999

Page 2

PATENT Attorney Docket No.: GENE1120-1

- 5. A facsimile was sent to Nancy Martorana, assistant to Dr. Dietmar Rabussay of GENETRONICS, Inc. on January 6, 2000 informing her that a viable home address for Inventor Filshie was not yet available (Exhibit D: facsimile to Nancy Martorana):
- 6. A telephone call to Inventor Filshie at Biocatalyst Yorkton, Inc. was placed on January 6, 2000, but contact with Inventor Filshie was not made;
- 7. A letter and second Declaration for Patent Application was sent by U.S. Certified Mail to Inventor Filshie on January 6, 2000 (Exhibit E: letter to Inventor Filshie and Receipt for U.S. Certified Mail);
- No executed Declaration for Patent Application has been received from Inventor 8. Filshie and Inventor Filshie has not responded to any communications from, and has not been in communication with the undersigned.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

No fee is deemed necessary in connection with the filing of this paper. However, if any fee is required, the Commissioner is hereby authorized to charge the amount of this fee, or credit any overpayments, to Deposit Account No. 07-1895. A copy of this Transmittal Sheet is enclosed.

Respectfully submitted,

Lisa A. Haile, Ph.D.

Registration No. 38,347

Telephone: (858) 677-1456 Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP 4365 Executive Drive, Suite 1600 San Diego, California 92121-2189

# Gray Cary Ware A Freidenrich LLP

4365 Executive Drive, San Diego, 92121-2189

Phone 858-677-1400

Fax: 858-677-1465

www.graycary.com

LISA A. HAILE, PH.D.

Writers Direct Dial: 858-677-1456 Internet: Ihaile@graycary.com



October 11, 1999

### Via FedEx

Dr. Dietmar Rabussay Vice President of Research & Development GENETRONICS, INC. 11199-A Sorrento Valley Road San Diego, CA 92121-1334

Re:

United States Patent Application 09/342,024

HIGH EFFICIENCY TRANSFECTION BASED ON LOW ELECTRIC

FIELD STRENGTH, LONG PULSE LENGTH

Inventors: Ed Nolan, et al. Filed: June 28, 1999

Our Docket No.: GENE1120-1

## Dear Dr. Rabussay:

The above-identified patent application was filed with the United States Patent and Trademark Office on June 28, 1999, and has been assigned Serial Number 09/342,024. A copy of the filing receipt and patent application as filed is enclosed for your files. You may now mark articles made in accordance with the invention with "Patent Pending" or "Patent Applied For." We will inform you of the serial number assigned by the PTO upon receipt of such information from the PTO.

In order to complete the formalities required to obtain our June 28, 1999 filing date, please have the inventors sign the enclosed Declaration and Assignment forms as indicated. In addition, please have the enclosed Power of Attorney By Assignee signed by an officer of Genetronics, Inc. and return the executed forms to us as soon as possible.

Also enclosed is a Verified Statement Claiming Small Entity Status form which, if applicable to this case, must be signed by an officer of Genetronics, Inc.

Please note that the declaration contains an acknowledgment of the inventor's duty to disclose all information of which he is aware that is material to the examination of the application. This is a continuing duty which does not terminate upon filing of the application. The same duty is imposed on us as attorneys. The purpose of the disclosure requirement is to ensure that the

SILICON VALLEY

SAN DIEGO

SAN FRANCISCO

**AUSTIN** 

LA JOLLA

IMPERIAL VALLEY

**MEXICO** 

## Gray Cary Ware & Freidenrich LLP

Dr. Dietmar Rabussay Vice President of Research & Development Genetronics, Inc. October 11, 1999 Page 2

Patent and Trademark Office has before it all of the prior art that may affect the validity of a patent. This has the effect of strengthening patents that ultimately are granted. Failure to satisfy the disclosure requirement may result in loss of patent rights, as well as other potentially serious consequences.

Accordingly, if you have not already provided us with all such information, we need it as soon as possible so that we can make an early determination as to its materiality, and can prepare an appropriate statement, if necessary, for filing with the application. For purposes of determining what information you should forward to us, we suggest you consider "material information" to include information relating to any publication, public uses or offers for sale of the invention or anything closely similar to it, occurring before the filing date of the application. If any such publications are patents, we suggest you consider them material no matter when issued.

As you may be aware, for a variety of reasons even "material information" may ultimately have little or no bearing on the patentability of the invention. For example, if a publication occurred less than a year before the filing date and after completion of the invention, it will not affect patentability. Moreover, an invention often can be distinguished over material information by appropriate argument to the Patent and Trademark Office, or by amendment of the claims.

In the meantime, if you have any questions or if I can provide any additional information, please do not hesitate to call.

Sincerely,

GRAY CARY WARE & FREIDENRICH LLP

Lisa A Haile Ph D

LAH/ep Enclosures

cc:

Ed Nolan

Robin Filshie

GT\6138438.1 104648-157591 ORIG. ID: SANA

SHIPPER'S FEDEX ACCOUNT NUMBER



PHONE: (619) 677-1456

FROM:

Lisa A. Haile, Ph.D.

Gray Cary Ware & Freidenrich LLP 4365 EXECUTIVE DRIVE, SUITE 1600

SAN DIEGO CA 921212189 US

TO:

PHONE: (999) 999-9999

**ROBIN FILSHIE** 

**406 RUSHTON ROAD** 

TORONTO, ONTARIO M6C 2X9 ON M6C2X9 CANADA (CA)

REF: LAH/21489[104648-157591]

TRK # 7903 0896 4701 FORM ID: 0430 INTL PRIORITY LETTER

No SED required,

BILL T/C: S 180581332

BILL D/T: \$ 180581332

FTSR 30.55

IRS / EIN: SHIP DATI

SHIP DATE: 120CT99 MAN WGT: 1 LBS

X4 YFHA

DESCRIPTION documents

HARMONIZED CODE

CTRY MFG

បទ

**CUSTOM VALUE:** 

CARRIAGE VALUE:

1.00 USD

1.00 USD

SIGNATURE: Lisa A. Haile, Ph.D.

The Warsaw Convention may apply and will govern and in most cases limit the liability of FEDERAL EXPRESS for loss or delay of or damage to your shipment, subject to the conditions of the contract on the bottom of this document.

Fold Here. Place in FedEx international air waybill pouch.

Place 2 originals (Consignee, Manifest/Billing) of this multipage waybill in pouch.

# **Next Step**

To print a receipt of your shipment, please click on "Shipping History".

A Charles Accorded Parkage : W Schedule Courses Winds a Decorde Exception & Charles History )

\* Processo, Completes & Cancel Shipment

WARNING: USE ONLY THE PRINTED ORIGINAL LABELS FOR SHIPPING TO ENSURE THE TIMELY DELIVERY OF YOUR PACKAGE. YOU MUST PLACE TWO (2) ORIGINALS OF THIS MULTIPAGE AIR WAYBILL IN THE POUCH ACCOMPANYING YOUR PACKAGE.

LEGAL TERMS AND CONDITIONS OF FEDEX SHIPPING DEFINITIONS. On this Air Waybill, "we", "our", "us", and "FedEx" refer to Federal Express Corporation, its subsidiaries and branches and their respective employees, agents, and independent contractors. The terms "you" and "your" refer to the shipper, its employees, principals and agents. If your shipment originates outside the United States, your contract of carriage is with the FedEx subsidiary, branch or independent contractor who originally accepts the shipment from you. If your shipment originates in Canada, your contract of carriage is with Federal Express Canada Ltd., its principals, subsidiaries, branches and affiliates, and their respective agents and independent contractors. The term "package" means any container

CUSTOMS COPY/COPIE DOUANES pas une autorisgiton de livraison de cet envoi sans la signature du destinatire. SENDER'S SIGNATURE & LIMBILITY LIMITATION/SIGNATURE DE L'EXPEDITEUR ETLIMITÉ DE RESPONSABILITÉ. By guinq us your histories que que les necessités de le libration de la propriété de l'individue de la libration de la propriété de l'individue de la libration de la propriété profit individue de l'individue de l'individue de la libration de l'individue de la l'individue de l'individu CO Attached Broker Zip/Postal Code/Code postal du houtler en douane Street Address Adresse: JUNIX + FIEILININ Dept. Floor No. Service Elage. ne Trés important pour la livraison: \_\_ - 8 \_\_ Complete Description of Contents/Harmonized Code/Description complete du contenu/Code systeme harmonise Recipients ID Number for Customs Purposes (e.g., E.INJBINJR,F.C./V.A.T. or as locally required) with destination du destinataire à l'usage des douanes (ex. E.I.N.A.E.R.F.C./T.V.A., ou selon les exigences locales) FX FCLYUN はいれている Postal Code/ZIP/Code posta ESA:EPA Enanded service sines Zona dentition the service CI Artached State/Province/État  $C \cap C$ N° demployé FedEx Auge N° demployé du véril Date Total Declared Value for Carrage Valeur totale déclarée pour le transport Specify Currency of Declared Valvi Précisez la devise de la valeur dec SHIPMENT INFORMATION/INFORMATIONS SUR L'ENVOI Dec Val Chro Valeur déclarée This is not an authorization to deliver this shipment without a recipient signature ! BROKER NAME/NOM DU COURTIER EN DOUANE 유민무의 SENDER'S SIGNATURE Required SIGNATURE DE L'EXPÉDITEUR Requise 400-8533 出てい Street Address/Adresse City/Country/Viile/Pays Handling Units Unités de manutentior CA Cargo Aircraft Only Avion-cargo uniquement oses deroperades der sur embelage FedEx

DUTIES AND TAXES/DROITS DE DOUANE ET TAXES FedEx International Priority Freight Dept./Floor No./Service/Étage: Shipments May Be Subject To Dutles And Taxes At Destination Les envois peuvent être soumis aux droits de douane et taxes du pays de destination 2 Bill Recipient

Argent liquide/
Bill 3rd Party
Chéque 1 Bill Sender A Certit Card Facturer l'expéditeur 4 Carte de crédit 유민교의 Other Packaging Autre emballage Postal Code/Code postal Must check one box/Une case dolt être cochée FedEx International Economy 70 [FedEx LetterEmelope rate not exiliable Tarif FedEx LetterEmelope non disponible] 604 Province 400-8533 Y 68 (As pre-attached Stepper's Y 69 (Stopes) Cachereton no pre-attacher of leaderflow) B OUI inspense of leaderflow) Not all options available to all destinations./Certine sent base disponibles pour toutes les destinations and Andréa & Federal Andréa & Federal à la succ. de Federa FedEx International Priority Deliver Saturday
Livrer le samedi DANGEROUS GOODS/MARCHANDISES DANGEREUSES FedEx Pak CO Calley brok D. TRANSPORTATION CHARGES/FRAIS DE TRANSPORT Not all options available to all destinations. Certaines options ne sont pas disponibles pour toutes les destinations. <u>ر</u> Bill Sender 4 Credit Card Facturer Festiveur 4 Carte de crédit FedEx International First (Pestal Code RequiredCode postal obligatolity) (Higher rates apply/Des terffe edEx Letter/Envelope Date of Shipment Date de Fenvoi 400-85338223 400-85338223 400-85338223 Ü

P. 1

ION RESULT REPORT ( JAN. 6.2000 : '.BAM ) \* \* \*

TTI

PERS. NAME FILE MODE PAGE RESULT DATE ADDRESS TIME TIME 570 JAN. 6. 10:15AM 918584103397 TES 2′58" P. 9 OΚ

# : BATCH M : MEMORY S : STANDARD

C : CONFIDENTIAL L : SEND LATER D : DETAIL

\$ : TRANSFER @ : FORWARDING F : FINE

P : POLLING E : ECM > : REDUCTION

4365 Executive Drive, Suite 1600 San Diego, CA 92121-2189 Tel: 858-677-1400 Fax: 858-677-1465 www.graycary.com

# **FAX TRANSMISSION COVER SHEET**

January 6, 2000

To:

Telephone:

Fax Number:

Nancy Martorana Genetronics, Inc. 858-410-3183

858-410-3397

From:

Lisa A. Haile, Ph.D.

858-677-1456

Client-Matter Number:

104648-990000

Re:

United States Patent Application No. 09/342,024

Entitled:

HIGH EFFICIENCY TRANSFECTION BASED ON LOW ELECTRIC

FIELD STRENGTH, LONG PULSE LENGTH

Filed: June 28, 1999

Inventor(s): Nolan, et al.

Our Docket No.: GENE1120-1

Pages: - 9 - (including this form)

Originals: □ will be mailed ☑ will not be mailed

If there is a problem with this transmission, please call (858) 677-1492/Elizabeth Fax Operator/Ext.

Message:

URGENT

URGENT

Please note that we are still awaiting receipt of the Declaration and Assignment forms signed by Ed Nolan for the above-identified application so that we may file with PTO. We ask that you please have these documents signed and faxed to us as soon as possible [FAX#: 858-677-1465]. Enclosed for your reference is our letter dated October 11, 1999.

Also, note that we are still not able to get a viable home address for Robin Filshie.

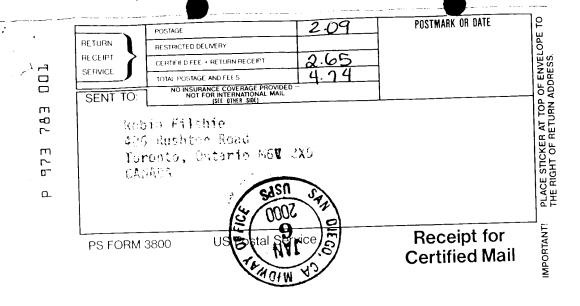
If you should have any questions, please do not hesitate to contact me.

Thank you.

#### CONFIDENTIALITY NOTICE

This communication is ONLY for the person named above. Unless otherwise indicated, it contains information that is confidential, privileged or exempt from disclosure under applicable law. If you are not the person named above, or responsible for delivering it to that person, be aware that disclosure, copying, distribution or use of this communication is strictly PROHIBITED. If you have received it in error, or are uncertain as to its proper handling, please immediately notify us by collect telephone and mail the original to us at the above address. Thank you.

(Form Rev. 7/26/96)



LAH/21489 104648-GENE1120-1

LINE 1 •

Robin Filshie 406 Rushton Road Toronto, Ontario M6C 2X9 CANADA ARTICLE

P 973 783 001

NUMBER

↑ FOLD AT PERFORATION ↑
INSERT IN STANDARD # 10 WINDOW ENVELOPE.

REFERENCE:

LAH/21489 104648-GENE1120-1



# Gray Cary Ware A Freidenrich LLP

Technology's legal edge<sup>sm</sup>

4365 Executive Drive, Suite 1600, San Diego, CA 92121-2189

Phone 858-677-1400 Fax 858-677-1465 www.graycary.com

LISA A. HAILE, PH.D.

Admitted to practice in California

Writer's Direct Dial: 858-677-1456 Internet: lhaile@graycary.com

January 6, 2000

By CERTIFIED MAIL

Robin Filshie 406 Rushton Road Toronto, Ontario M6C 2X9 CANADA



Re:

United States Patent Application No. 09/342,024

Entitled: HIGH EFFICIENCY TRANSFECTION BASED ON LOW ELECTRIC

FIELD STRENGTH, LONG PULSE LENGTH

Filed: June 28, 1999

Inventor(s): Nolan, et al.

Our Docket No.: GENE1120-1

Dear Dr. Filshie:

Please note that we still have not received the executed Declaration and Assignment forms in order to obtain our June 28, 1999 filing date. Enclosed please find these documents along with our October 11, 1999 letter and the application as filed. We ask that you please return the signed documents as soon as possible, preferably by facsimile [858-677-1465] so that we may file with the PTO in due course.

If you should have any questions, please do not hesitate to contact me.

Very truly yours,

GRAY CARY WARE & FREIDENRICH LLP

By: Lisa A. Haile/09
Lisa A. Haile, Ph.D.

LAH:ep Enclosure

Gray Cary\GT\6162792.1 104648-990000

SILICON VALLEY SAN DIEGO SAN FRANCISCO AUSTIN SACRAMENTO LA JOLLA IMPERIAL VALLEY MEXICO